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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,301	08/10/2001	Dan Kikinis	P5064	7434

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EXAMINER

PHILPOTT, JUSTIN M

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 04/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/927,301

Applicant(s)

KIKINIS, DAN

Examiner

Justin M Philpott

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1,4
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Priority*

1. In the oath/declaration of the instant application, Applicant has claimed priority as a continuation-in-part under 35 U.S.C. 120 and 119 to pending U.S. Patent Application No. 09/160,558, filed September 24, 1998. Any claim in a continuation-in-part application which is directed *solely* to subject matter adequately disclosed under 35 U.S.C. 112 in the parent nonprovisional application is entitled to the benefit of the filing date of the parent nonprovisional application. However, if a claim in a continuation-in-part application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 U.S.C. 112 in the parent nonprovisional application, but which was first introduced or adequately supported in the continuation-in-part application, such a claim is entitled only to the filing date of the continuation-in-part application. See *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995); *Transco Products, Inc. v. Performance Contracting Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994); *In re Von Lagenhoven*, 458 F.2d 132, 136, 173 USPQ 426, 429 (CCPA 1972); and *Chromalloy American Corp. v. Alloy Surfaces Co., Inc.*, 339 F. Supp. 859, 874, 173 USPQ 295, 306 (D. Del. 1972). Claims 1-15 of the instant application recite at least a feature (e.g., session events conducted under SIP) which was not disclosed or adequately supported by a proper disclosure under 35 U.S.C. 112 in the parent nonprovisional application, but which was first introduced or adequately supported in the continuation-in-part application. Thus, claims 1-15 (i.e., all presently pending claims) are entitled only to the filing date of the continuation-in-part application.

***Information Disclosure Statement***

2. The information disclosure statement filed August 10, 2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Specifically, U.S. Patent Application No. 09/160,558 has been listed, but a copy of this document has not been provided. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

***Specification***

3. The disclosure is objected to because of the following informalities: the reference number "423" is used in the specification to identify two different elements, namely "telephony trunk 423" (page 21, line 27) and "data server 423" (page 23, line 5). Appropriate correction is required.

***Claim Objections***

4. Claim 13 is objected to because of the following informalities: "and", or similar language, should be inserted between "obtained" and "passed back". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 4, 7, 11-13 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation “the software suite” in claim 1. There is insufficient antecedent basis for this limitation in the claim. Applicant may overcome this rejection by amending the claim to change, e.g., “the” to “a”.

Claim 7 recites the limitation “the source party” (page 31, line 18) in claim 7. There is insufficient antecedent basis for this limitation in the claim. Applicant may overcome this rejection by amending the claim to change, e.g., “a source” (line 8) to “a source party”, or “the source party” (line 18) to “the source”.

Claim 11 recites the limitation “the session initiation and management protocol” in claim 7. There is insufficient antecedent basis for this limitation in the claim. Applicant may overcome this rejection by amending the claim to change, e.g., “the session initiation and management protocol” to “the session initiation protocol”.

Claims 12 and 13 recite the limitation “the requesting party” in claim 7. There is insufficient antecedent basis for this limitation in the claim. Applicant may overcome this rejection by amending claim 7 to change, e.g., “receiving a request” (page 31, line 11) to “receiving a request from a requesting party”.

Claim 15 recites the limitation “the routing node” in claim 7. There is insufficient antecedent basis for this limitation in the claim. Applicant may overcome this rejection by amending the claim to change, e.g., “the routing node” to “the routing point”.

*Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 1-5, 7-10, 13 and 14 are rejected under 35 U.S.C. 102(a) as being anticipated by Schulzrinne in the International Publication No. WO 00/76158 A1.

Regarding claims 1 and 7, Schulzrinne teaches a system for routing communication events over a data-packet-network (see, e.g., page 2, lines 18-22 and also FIG. 33) using an IP session initiation protocol SIP (see, e.g., page 3, lines 11-14) comprising: a server application (enhanced services performed by server 3325 in FIG. 33, e.g., see page 29, lines 7-22) running on the network for computing and serving routing determinations per request; a session management application (e.g., page 3, lines 15-17; page 16, lines 11-30 regarding Scheduling manager; page 26, lines 14-18 regarding CreateSipCall(); as well as FIGS. 13A-13F) running on the network for initiating and managing routed and established session events; a parsing application (SIPParse(), e.g., page 26, lines 18-20) running on the network for parsing request data received under SIP; and a conversion application (e.g., page 11, line 12 regarding conversion subsystem 130; as well as page 26, lines 20-22 regarding SIP\_task) running on the network for converting data received under SIP into a routing request; characterized in that all received communication requests for routing are in the form of the SIP (e.g., page 9, lines 19-20), are parsed and converted into routing requests processed by the server application, and

routed to determined destinations, and wherein events are established as session events conducted under the SIP. Furthermore, regarding claim 7, Schulzrinne teaches determining the best destination (e.g., first contacted node to respond, page 29, lines 7-22) according to the request (session initiation signal) and returning the result (response) to the routing point (server 3325), and establishing the communication event between the source (calling party) and the determined destination under the SIP.

Regarding claims 2 and 8, Schulzrinne teaches the data-packet-network comprises the Internet network (see FIG. 33).

Regarding claims 3 and 9, Schulzrinne teaches the Internet further connects to a LAN network (e.g., see page 11, line 9).

Regarding claims 4 and 10, Schulzrinne further teaches a software suite controls internal routing within a communication center (e.g., 3320, 100 in FIG. 33).

Regarding claims 5 and 11, Schulzrinne teaches the session management application follows SIP protocols (e.g., page 3, lines 11-14).

Regarding claim 6, Schulzrinne further teaches the communication events are sourced from clients (e.g., user controls 169 within appliance 100 in FIG. 4) of the center and routed to agents or automated systems at work within the center (e.g., digital signal processing subsystem 120, Ethernet controller subsystem 110, RAM 152, ROM 142).

Regarding claim 12, Schulzrinne teaches the body content of the request is an electronic form populated by the requesting party (e.g., see FIG. 29).

Regarding claim 13, Schulzrinne teaches additional information (e.g., current SIP address, page 29, lines 20-22) pertinent to the requesting party not originally part of the request

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is obtained and passed back to the routing point along with the determination results (i.e., first node to respond to the initiation request).

Regarding claims 14 and 15, Schulzrinne teaches the session may be established and maintained by the routing node (server) or by a network-connected node other than the routing node (server) (e.g., page 8, lines 13-18 with reference to FIG. 2).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,438,114 to Womack et al. discloses a method and apparatus for enabling multimedia calls using session initiation protocol, and

U.S. Patent Application Publication No. 2002/0122547 by Hinchey et al. discloses a method and apparatus for route selection.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M Philpott whose telephone number is 703.305.7357. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on 703.308.6602. The fax phone numbers for the organization where this application or proceeding is assigned are 703.872.9314 for regular communications and 703.872.9314 for After Final communications.



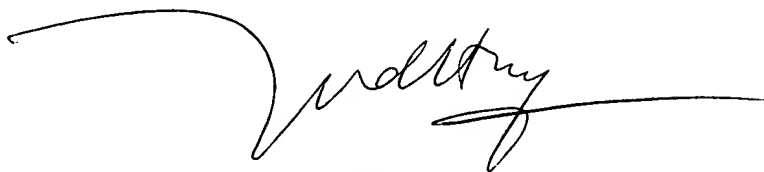
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.4750.

Justin M Philpott



April 10, 2003



HUY D. VU  
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